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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,753	10/20/2003	Chikashi Okamoto	ASA-1003-02	9276

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SUITE 370  
ALEXANDRIA, VA 22314

EXAMINER

VIGUSHIN, JOHN B

ART UNIT	PAPER NUMBER
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2841

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/687,753

Applicant(s)

OKAMOTO ET AL.

Examiner

John B. Vigushin

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2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15 and 18 is/are rejected.
- 7) ☒ Claim(s) 16, 17, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/856,758.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The present Office Action is responsive to Applicant's Amendment filed April 10, 2006. The Examiner acknowledges the amendments to Claims 15, 16, 18 and 19. Claims 15-20 remain pending in the instant amended Application.

### **Rejections Based On Prior Art**

2. The following references were relied upon for the rejections hereinbelow:

Blanc et al. (US 6,437,985 B1)†                      Usami et al. (US 5,689,136)††

Kamiyama (JP62-25096 A)††

†Already made of record in Examiner's PTO-Form 892 in the previous Office Action of December 08, 2005.

††Already made of record in Applicant's IDS PTO-Form 1449 filed October 20, 2003.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 15 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Blanc et al.

As to Claim 15, Blanc et al. discloses, in Figs. 2-4 and 12: a method of mounting an electronic circuit chip 4 together with another planar electric element (antenna coil 2) to a foldable rectangular sheet D--i.e., as shown in an embodiment in Fig. 6, which is the material portion of sheet 1 defined by the demarcation line L in Fig. 4 (col.8: 13-14) and singulated from the roll--having first sides (defined by the vertical lines L in Fig. 4 and the corresponding vertical sides in Fig. 6) and second sides (defined by the horizontal lines L in Fig. 4 and the corresponding horizontal sides in Fig. 6) which are not wider than the first sides (note that the device D as demarcated by lines L in Fig. 4 and in the embodiment of Fig. 6 is a square--a special case of a rectangle--and the second, i.e., horizontal sides, are not wider than the first, i.e., vertical sides; specifically, the width of the horizontal sides are equal to the width of the vertical sides), the electronic circuit chip-mounted sheet D comprising a finished product that is foldable along at least one fold line of the foldable rectangular sheet D (Fig. 12; col.6: 50-65, col.7: 47-61, and col.7: 38-43 and 62-67 teach that it is the finished product D that is foldable and is capable of being subjected to repetitive folding without deterioration), the method being characterized in that the electronic circuit chip 4 is mounted to the foldable rectangular sheet D (Fig. 4) at a position which is not on any one of: (i) a line passing through positions of one-half of the length of the first (vertical) sides and being parallel with the second (horizontal) sides, (ii) lines passing respectively through positions of one-third or one-fourth of the length of the first (vertical) sides and being

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parallel with the second (horizontal) sides, and (iii) a line passing through positions of one-half of the second (horizontal) sides and being parallel with the first (vertical) sides (Fig. 4; col.6: 50-57; col.7: 47-67; col.8: 1-6).

As to Claim 18, Blanc et al. discloses, in Figs. 2-4 and 12: a foldable rectangular sheet D—i.e., as shown in an embodiment in Fig. 6, which is the material portion of sheet 1 defined by the demarcation line L in Fig. 4 (col.8: 13-14) and singulated from the roll—to which an electronic chip 4 is mounted (Fig. 4), the electronic circuit chip-mounted sheet D comprising a finished product that is foldable along at least one fold line of the foldable rectangular sheet D (Fig. 12; col.6: 50-65, col.7: 47-61, and col.7: 38-43 and 62-67 teach that it is the finished product D that is foldable and is capable of being subjected to repetitive folding without deterioration), the foldable rectangular sheet having first sides (defined by the vertical lines L in Fig. 4 and the corresponding vertical sides in Fig. 6) and second sides (defined by the horizontal lines L in Fig. 4 and the corresponding horizontal sides in Fig. 6) which are not wider than the first sides (note that the device D as demarcated by lines L in Fig. 4 and in the embodiment of Fig. 6 is a square—a special case of a rectangle—and the second, i.e., horizontal sides, are not wider than the first, i.e., vertical sides; specifically, the width of the horizontal sides are equal to the width of the vertical sides), characterized in that the electronic circuit chip 4 (Fig. 4) is located at a position which is not on any one of: (i) a line passing through positions of one-half of the length of the first (vertical) sides and being parallel with the second (horizontal) sides, (ii) lines passing respectively through positions of one-third or one-fourth of the length of the first (vertical) sides and being parallel with

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the second (horizontal) sides, and (iii) a line passing through positions of one-half of the second (horizontal) sides and being parallel with the first (vertical) sides (Fig. 4; col.6: 50-57; col.7: 47-67; col.8: 1-6).

5. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Kamiyama.

Kamiyama discloses, in Figs. 1 and 2, and in the English language Abstract: a foldable rectangular sheet 1 to which an electronic chip 3 is mounted, the electronic chip-mounted sheet comprising a finished product (IC card) that is foldable along at least one fold line 2B of the foldable rectangular sheet 1, the foldable rectangular sheet 1 having first (horizontal) sides and second (vertical) sides which are not wider than the first (horizontal) sides, characterized in that the electronic circuit chip 3 is located at a position which is not on any one of: (i) a (vertical) line 2B passing through positions of one-half of the length of the first (horizontal) sides and being parallel with the second (vertical) sides and (ii) a (horizontal) line 2B passing through a position of one-half of the second (vertical) sides and being parallel with the first (horizontal) sides.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kamiyama in view of Usami et al.

I. Kamiyama discloses, in Figs. 1 and 2, and in the English language Abstract: a method of mounting an electronic circuit chip 3 to a foldable rectangular sheet 1 having first (horizontal) sides and second (vertical) sides which are not wider than the first (horizontal) sides, the electronic circuit chip-mounted sheet 1 comprising a finished product (IC card) that is foldable along at least one fold line 2B of the foldable rectangular sheet 1, the method being characterized in that the electronic chip 3 is mounted to the foldable rectangular sheet 1 at a position which is not on any one of: (i) a (vertical) line 2B passing through positions of one-half of the length of the first (horizontal) sides and being parallel with the second (vertical) sides and (ii) a (horizontal) line 2B passing through a position of one-half of the second (vertical) sides and being parallel with the first (horizontal) sides.

II. Kamiyama discloses mounting an electronic circuit chip 3 to the foldable rectangular sheet 1 that constitutes the IC card but does not teach mounting an

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electronic circuit chip 3 **with another planar electric element** to the foldable rectangular sheet 1 (bold/underlined emphasis added).

III. Usami et al. discloses mounting an electronic chip 114 with another planar electric element (coil 115) to a flexible rectangular IC card 113 for the purpose of providing power to the chip 114 and transferring data to/from the chip 114 (col.10: 30-48).

IV. Since Kamiyama and Usami et al. are both in the same field of endeavor, then mounting the chip in Kamiyama with another planar electric element, such as a coil, to the foldable rectangular sheet, for the same purpose as that taught by Usami et al., would have been readily recognized in the pertinent art of Kamiyama.

V. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the IC card of Kamiyama by mounting the electronic chip with another planar electric element, i.e., a coil, as taught by Usami et al., in order to provide the chip with power and transfer data to/from the chip in an electronic application of the IC card of Kamiyama, as taught by Usami et al.

#### ***Allowable Subject Matter***

9. Claims 16, 17, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



***Response to Arguments***

10. Applicant's arguments, see pp.5-6 of Applicant's instant Amendment, filed April 10, 2006, with respect to the rejection(s) of claim(s) 15 and 18 over Tuttle et al. (US 5,779,839) under 35 USC § 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration of Applicant's amendments to base Claims 15 and 18, new grounds of rejection have been set forth in the present Office Action in view of prior art already of record in the instant Application; specifically, Blanc et al. (US 6,437,985 B1), Kamiyama (JP62-25096 A) and Usami et al. (US 5,689,136).

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

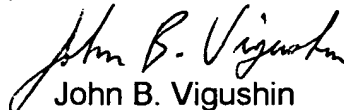
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Vigushin whose telephone number is 571-272-1936. The examiner can normally be reached on 8:30AM-5:00PM Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
John B. Vigushin  
Primary Examiner  
Art Unit 2841

jbv  
June 25, 2006